Remarks

This Application has been carefully reviewed in light of the Office Action mailed February 12, 2004. Claims 1-43 are pending and stand rejected. Reconsideration and allowance of Claims 1-43 is respectfully requested in view of the following remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 102

The Examiner rejects Claims 1, 4-5, 8-13, 15, 18-19, 22-27, 29-30, 33-34, and 37-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,774,868 to Cragun ("*Cragun*"). Applicants respectfully traverse these rejections for at least the reasons discussed below.

First, Applicants traverse the Examiner's interpretation of various elements of the claims. While the Examiner must give the pending claims "their most reasonable interpretation," this interpretation must be (1) "consistent with the specification"; and (2) "consistent with the interpretation that those skilled in the art would reach." MPEP §2111; *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999). Applicants submit that several interpretations are improper because they are inconsistent with both the specification and the interpretation that those skilled in the art would reach. For example, the Examiner appears to equate "a purchase," "items," and "sales promotion" in *Cragun* with "a content request from a user in a current interactive session," "user-requested content," and "additional content," respectively, as recited in independent Claims 1, 15, 29, and 30. Yet the present specification discloses that "content server 14 receives a content request from user 12, which may be a request for a particular web page of a website associated with the content server 14, [and] communicates the rendered web page to the user 12." (Page 6, lines 5-12) The specification then discloses that "[c]ontent server 14 may generate, render, and communicate content to users 12 in the form of Hypertext Markup Language (HTML) pages, Extensible Markup Language (XML) pages, or in any other scripted page or other appropriate format." (Page 6, lines 18-20) Applicants respectfully submit that the Examiner's use of "a purchase," "items," and "sales promotion" in *Cragun* is not consistent with "a content request from a user in a current interactive session," "user-requested content," and "additional content," respectively, as used in the specification or the interpretation that those skilled in the art would reach.

Second, even if the Examiner's interpretations were proper, *Cragun* would still fail to disclose, teach or suggest various limitations recited in independent Claim 1.

For example, *Cragun* does not disclose, teach, or suggest "the rendering engine further operable to render the user-requested content, including the additional content concerning the item," as recited in Claim 1. The Examiner cites Column 4, lines 15-27 of *Cragun* as supporting that either the server or the output device of *Cragun* teaches the rendering engine recited in Claim 1. (*See* Office Action, Page 2) Applicants respectfully submit that *Cragun* teaches no such thing. Neither the server nor the output device of *Cragun* teaches the claimed rendering engine because neither components render the item being purchased (what the Examiner claims is the "user-requested content").[1] Instead, the cited portion of *Cragun* teaches that the system "uses neural networks to identify items that are missing from a purchase transaction that are members of a purchase class otherwise represented in the purchase transaction" and that "the missing items can then be the subject of a purchase suggestion, an automatically dispensed coupon, or other sales promotion indicated by an output device 17 such as a printer or display terminal." (*Cragun*, Column 4, lines 15-22) Further, *Cragun* discloses that the purchased item is from "an inventory of items." (*Cragun*, Abstract) There is simply no rendering of the item by either the server or the output device. Accordingly, *Cragun* fails to disclose, teach, or suggest "the rendering engine further operable to render the user-requested content, including the additional content concerning the item," as recited in Claim 1.

As another example, *Cragun* fails to disclose, teach, or suggest "a rules engine operable to . . . communicate the additional content concerning the item to the rendering engine for incorporation in the user-requested content" as recited in Claim 1. The Examiner cites Column 17, line 61 through Column 18, line 6 of *Cragun* in support of this rejection, implying that *Cragun* teaches incorporating sales promotions in the item or purchase transaction. (*See* Office Action, Page 3) However, Applicants respectfully submit that

---

[1]   If the Examiner is asserting that the "purchase request" or the "purchase transaction" teaches the "user-requested content" as recited in Claim 1, Applicants likewise submit that neither the server nor the output device of *Cragun* renders the "purchase request" or the "purchase transaction." Moreover, neither the "purchase request" nor the "purchase transaction" are communicated "to the user in the current interactive session to satisfy the user-supplied content request" as recited in Claim 1.

Cragun does not teach what the Examiner claims. In contrast, the cited portion of *Cragun* merely discloses that sales promotions are generated based on – not incorporated in – purchased items. More specifically, *Cragun* states that the system provides "the predicted sales purchase data to the purchase advisor subsystem and its neural networks. As described above, the purchase advisor subsystem will segment the purchase items into purchase classes and generate selected sales promotions, such as purchase suggestions." (*Cragun*, Column 17, lines 62-67) There is simply no disclosure, teaching, or suggestion in *Cragun* that the sales promotion is incorporated in either the purchase transaction (what the Examiner claims is the "content request") or the item (what the Examiner claims is the "user-requested content").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In addition, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Applicants respectfully submit that the requirements for a proper anticipation rejection have not been met in this case.

For at least these reasons, *Cragun* fails to disclose, teach, or suggest the limitations recited in independent Claim 1. Independent Claims 15, 29, and 30 recite certain substantially similar limitations. Applicants respectfully request reconsideration and allowance of independent Claims 1, 15, 29, and 30, together with all claims that depend on independent Claims 1, 15, 29, and 30.

Rejections Under 35 U.S.C. § 103

The Examiner rejects Claims 6-7, 14, 20-21, 28, 35-36, and 43 under § 103(a) as being unpatentable over *Cragun*. The Examiner rejects Claims 2-3, 16-17, and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over *Cragun* in view of U.S. Patent No. 6,266,649 to Linden ("*Linden*"). First, these claims depend on independent claims shown to be allowable above, and are themselves allowable at least by virtue of their dependencies on those independent claims. Second, for at least the reasons outlined above in regard to independent Claims 1, 15, 29, and 30, both *Cragun* and the proposed *Cragun-Linden*

combination fail to disclose, teach, or suggest various limitations recited in Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43. Applicants respectfully request reconsideration and allowance of Claims 6-7, 14, 20-21, 28, 35-36, and 43.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner believes that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Applicants do not believe that any fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

Christopher W. Kennerly
Reg. No. 40,675

Date: April 12, 2004

Correspondence Address:
Baker Botts L.L.P.
2001 Ross Avenue, 6th Floor
Dallas, Texas 75201-2980
(214) 953-6812

Customer Number: **05073**